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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------|
| 10/668,216 | 09/24/2003 | Yasuhiro Yoneda | 1422-0603P | 1568 |
| 2292 7590 12/21/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | EXAMINER MARCHESCHI, MICHAEL A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1793 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 12/21/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/668,216

Applicant(s)

YONEDA ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following action is made **non final** because applicants requested a suspension of action (see RCE papers filed 4/30/07), however, an office action went out before this time period expired.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being obvious over EP 1 020 501 in view of Liu et al. and/or Ina et al. and further in view of Taira et al. (216) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 10/9/07 have been fully considered but they are not persuasive.

Applicants argue that the prior art does not teach colloidal silica particles which meet the formula of claim 1 in a polishing composition with a pH of 10.5-12. The examiner disagrees because, as defined in the previous office action, the combined references clearly teach such a composition.

Applicants argue Liu (795) and Ina (803), as not teaching colloidal silica which meet the claimed formula with a pH of 10.5-12. In response to this, applicants are arguing these references individually and not in combination, as applied, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants also present arguments to EP (836). The examiner is unclear as to these arguments because the previous rejection did not rely on EP (836) but EP 1 020 501.

Applicants also argues the instantly claimed invention is reference to the YONEDA declaration filed 10/9/07.

The declaration under 37 CFR 1.132 filed 10/9/07 is insufficient to overcome the rejection of claims based on the above rejection as set forth in the last Office action because: the data provided therein (1) does not show criticality for the entire pH range (data does not show endpoints of the claimed range, etc.), (2) the data provided therein does not show criticality for the entire inorganic particle size range (data does not shown endpoints of the claimed range, etc.), (3) the data defined in the declaration is for compositions containing defined amount of inorganic and organic particles, yet the instant claims define no amounts, (4) the data defined in the declaration is for compositions that use specific types of polymers and thus do not show that any and all polymers within the scope of thermoplastic or thermosetting resins will yield the desired results (the results show no basis for interpreting that any and all polymers within the scope of the claims will provide the same results) and (5) the size data defined in the declaration is not commensurate with the size relationship formula defined in the claims (formula is much more broader than what is defined in the declaration). For instance, if the size of the colloidal silica is 130 nm, the size of the polymer particle is ≤ 180 nm, however, nowhere in the declaration or specification data shows criticality for this value or a value so close as to show a trend in the results for this value. The maximum value defined is 138 nm and this is well below size defined above. The same holds true for other size values for the polymer particles.

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In summary, the data defined in the declaration (1) does not show criticality for any and all sizes for the individual particles that meet the claimed formula and (2) the data defined in the declaration is not commensurate in scope with the instant claims (i.e. data in declaration defines specific compositions and these composition, when taken together, are much more narrower than what is claimed).

Finally, the EP reference clearly discloses that the size of the polymer particles D_p is not more than the size of the inorganic particles D_i (see [0054]-i.e. $D_p < D_i$). In view of this, the D_p value will always be $< D_i + 50$, thus meeting the claimed formula. In view of this, the instant declaration also does not compare the instant claims to what is clearly disclosed in the reference in terms of the size relationship. Although a showing of criticality for the claimed range can rebut a prima facie case of obviousness, the EP 501 reference literally discloses inorganic size values that read on the claimed values (i.e. 50 nm as defined in section [0055] and 120 nm as defined in section [0059]). In view of the reference literally teaching the claimed size values, it is the examiners position that reliance on unexpected results of the claimed range can not be properly established.

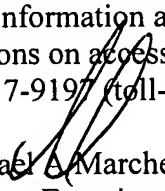
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM


Michael A. Marcheschi
Primary Examiner
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